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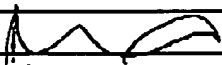
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<b>TRANSMITTAL FORM</b>  <i>(to be used for all correspondence after initial filing)</i>	Application Number	09/916,247	
	Filing Date	July 30, 2001	
	First Named Inventor	COTE	
	Art Unit	1723	
	Examiner Name	MENON, Krishnan S.	
Total Number of Pages in This Submission	5	Attorney Docket Number	4320-347

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# Bereskin & Parr

INTELLECTUAL PROPERTY LAW

Appl. No : 09/916,247 Confirmation No.: 9131  
 Applicant : COTE et al.  
 Filed : July 30, 2001  
 Title : CHEMICAL CLEANING BACKWASH FOR NORMALLY  
 IMMERSED MEMBRANES  
 TC./A.U. : 1723  
 Examiner : MENON, Krishnan S.  
 Docket No. : 4320-347  
 Customer No. : 001059

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May 12, 2006

## REPLY BRIEF

The Appellants make the following submissions in reply to the Response to Arguments section of the Examiner's Answer. The Appellants do not admit any points made in the Examiner's Answer that are not specifically addressed below.

### 102(b) Rejection of Claims 26-36 Over the Smith References

The Appellants do not agree with the summary of their argument given by the Examiner at page 12 of the Examiner's Answer. One dispute between the Appellants and the Examiner was touched on by the Examiner but can be better summed up as follows. The Examiner believes that disclosure of one claim element (draining the tank) in the context of a prior art process described in the Smith reference combined with the disclosure of other claim elements in a novel process described in the Smith reference (in which the tank is not drained) can support an anticipation reference. The Appellants submit that elements from two distinct processes cannot be combined to create an obviousness rejection unless the reference teaches such a combination, which it does not. However, the Examiner's Answer does not mention the Appellants further argument that claim 26 requires various operations, including draining a tank, to occur at least

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once a week. Even the discussion of the prior art process in the Smith reference does not include this element and so the Examiner's combination of the prior art process and novel process, even if it could be properly made, still fails to anticipate the claim.

The Examiner further argues that, "even if the Smith reference were completely silent over the draining of the tank, this claim would still not be patentable for draining the tank, because people commonly drain the process equipment for cleaning, and such a step would not make the claim patentable". The Appellants submit that this statement is unsupported by evidence, and fails to consider all elements of the claim. This statement also relates to obviousness considerations while the rejection is for anticipation only.

Further, in relation to claims 29 and 30, the Examiner refers to the optimization of result-effective variables and so makes another obviousness related statement. The Examiner's statements on claim 31 further imply obviousness related considerations and ignore the actual disclosure in the Smith reference. The Appellants submit that all such obviousness related arguments should be ignored since they have no place in the current anticipation rejection, and the Appellants have already overcome obviousness rejections, as discussed at page 4, part I, of their Brief in Support of Appeal.

Regarding claim 33, the Appellants submit that the claim does have specific limitations as are stated in the claim and that the Smith reference does not disclose these limitations.

Regarding claim 34, the Appellants submit that an implication in the Smith reference that a step is unnecessary does not anticipate a claim having the step.

#### **102(e) Rejection Over the Del Vecchio Reference**

Regarding claim 26, the Appellant submits that the Examiner's Answer does not provide evidence of disclosure in the Del Vecchio reference sufficient to support the alleged anticipation.

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Regarding claim 27, the Appellants submit that the claim requires the tank to be drained at least once a day and that the Examiner's Answer does not provide evidence sufficient to support the alleged anticipation.

Regarding claims 28 and 31, column 12, lines 30-40 of the Del Vecchio reference refers to pulsed cleaning during a recovery cleaning and so such pulsed cleaning cannot provide the steps of claim 26 performed between recovery cleanings as required by claims 28 and 31.

The Examiner has conceded that claim 33 is not anticipated and has not provided a prima facie case of obviousness.

Regarding claim 34, column 12, lines 30-40, in conjunction with column 12, lines 12-30, refer to backwashing with permeate while a membrane cartridge is being soaked in a chemical. This does not provide a backwash with permeate after step (f) of claim 26 in a first cycle but before starting a subsequent cycle, as required in claim 34.

Regarding claim 35, column 12, lines 30-40 do not say how a mixture of permeate and cleaning chemical is created. Column 11, lines 62-65, read starting from line 59, refers to flow through line 296 while valve 295 is closed which does not provide flowing water to the permeate side of the membranes as required by the claim.

### **103 Rejection of Claims 29, 30 and 32 Over Del Vecchio in view of Smith**

Regarding claims 29 and 30, the Examiner's reference to the optimization of the weekly CT parameter is insufficient to create a prima facie case of obviousness at least because the Examiner has not established that CT is taught to be a result-effective variable in the context of claim 26 in either reference and has not established that the alleged considerations of quality of water and process flow would obviously lead to the claimed ranges starting from any range or value provided in the cited references. The Appellants submit Examiner's Answer does

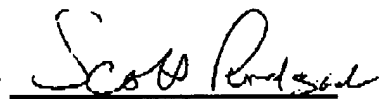
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not satisfy the requirements of MPEP 2144.03II A or B for a rejection based on the alleged obviousness of a range of a parameter.

Respectfully submitted,

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